

Application Number 10/644,484

Response to Office Action mailed September 20, 2007

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This Response is responsive to the Office Action dated September 20, 2007. Applicant has not amended the claims. Claims 1, 7-9, 11-13, 15, 19, 20, 23, 25 and 27-30 are pending.

Claim Rejection Under 35 U.S.C. § 102

In the Office Action, the Examiner rejected claims 1, 7-9, 11-13, 15, 19, 20, 23, 25 and 27-30 under 35 U.S.C. 102(b) as being anticipated by Kaneko (US 2003/0221066). Applicant respectfully traverses the rejection. Kaneko fails to disclose each and every feature of the claimed invention, as required by 35 U.S.C. 102(b), and provides no teaching that would have suggested the desirability of modification to include such features.

Claims 1, 7-9, 11-13, 23 and 25

Claim 1 requires a memory card comprising a memory, a first connector electrically coupled to the memory and conforming to a first connector standard, and a second connector electrically coupled to the memory and conforming to a second connector standard, wherein the first connector standard comprises a host computer connector (HCC) standard and the second connector standard comprises a device communication connector (DCC) standard. The memory card also includes a controller that controls the memory and controls output via the first connector and the second connector, wherein the first and second connectors are electrically coupled to the memory through the controller and wherein the controller comprises a memory controller integrated with a first connector controller conforming to the first connector standard and integrated with a second connector controller conforming to the second connector standard, wherein at least one of the first connector and the second connector comprises a retractable connector that can be positioned in an extended position and a retracted position.

Applicant submits that Kaneko fails to disclose or suggest the invention defined in independent claim 1. For example, Kaneko fails to disclose or suggest *wherein at least one of the first connector and the second connector comprises a retractable connector that can be positioned in an extended position and a retracted position*, as required by claim 1. In the Office Action, the Examiner cited to element 23 in FIG. 3 of Kaneko as allegedly teaching a retractable

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connector.¹ Applicant respectfully disagrees with the Examiner's characterization of the reference. Although Kaneko describes element 23 as some type of connector that may be detached from a memory card, the reference makes no mention whatsoever to the connector being retractable, let alone whether or not the connector can be positioned in an extended position and a retracted position as is required by Applicant's claim 1. Consequently, the reference fails to disclose or suggest all of the limitations of independent claim 1.

Dependent claim 11 further defines the retractable connector feature of the memory card by reciting a housing defining a slot for the retractable connector, and a first electrical contact on the retractable connector and a second electrical contact within the slot, wherein the first electrical contact couples to the second electrical contact when the retractable connector is extended from the slot. Kaneko fails to disclose or suggest a memory card containing these features. In support of the rejection, the Examiner merely stated that "elements 25, 27 are within the connector 36."² Such a rejection and explanation are clearly deficient. It appears that the Examiner is now characterizing the connector wiring 36 in connector 23 as the retractable connector of Applicant's claim 11. Again, Applicant respectfully disagrees with this characterization. Kaneko makes no reference to the connector wiring as being retractable nor does the reference disclose the connector wiring as being able to be positioned in an extended and a retracted position as required by claim 11. Moreover, Kaneko makes no reference to a housing in the memory card that defines a slot for the connector as required by claim 11. Applicant is entirely confused by this rejection and respectfully requests further clarification if this rejection is maintained in any subsequent Office Action.

Referring back to independent claim 1, the Kaneko reference also fails to disclose or suggest a memory card having a first connector conforming to a first connector standard, a second connector conforming to a second connector standard, wherein the first connector standard comprises a host computer connector (HCC) standard and the second connector standard comprises a device communication connector (DCC) standard and at least one of the connectors comprises a retractable connector. In support of the rejection, the Examiner pointed to the first and second connector terminals (25 and 27) of two different memory cards (21 and

¹ Office Action dated September 20, 2007, pg. 3, lines 8-10.

² Office Action dated September 20, 2007, pg. 5, lines 1-2.

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22) as allegedly teaching a first connector and a second connector conforming to two different connector standards.³ Again, Applicant respectfully disagrees with this characterization of the reference. The connector terminals 25 and 27 shown in FIG. 3 of Kaneko are shown as identical terminals and are described without distinction. As such, Applicant fails to see how the reference allegedly teaches that these connectors conform to two different connector standards. Moreover, connector terminals 25 and 27 should not be confused with I/O terminals 24 and 26. Unlike the I/O terminals 24 and 26, which are designed to connect to applicable devices outside of each of the memory cards, the connector terminals 25 and 27 applied by the Examiner are designed merely to internally connect other SD memory cards to each other.⁴ Kaneko fails to mention that connectors 25 and 27 may be used to connect a memory card to a host computer via a host computer connection (HCC) standard. Moreover, to the extent that Kaneko may disclose other connectors or I/O terminals that conform to two different standards, any such connectors or terminals are not retractable. Consequently, Kaneko fails to disclose or suggest all of the requirements of Applicant's claim 1.

In addition to the deficiencies already mentioned above with respect to the rejection of claim 1, the Examiner admitted in the rejection that FIG. 3 does not show a first connector controller and a second connector controller as defined in Applicant's claim 1.⁵ Moreover, the Examiner failed to indicate where in the specification such elements may be found. Applicant reminds the Examiner that in order to support an anticipation rejection under 35 U.S.C. 102(b), it is well established that a prior art reference must disclose each and every element of a claim. This well known rule of law is commonly referred to as the "all-elements rule."⁶ If a prior art reference fails to disclose any element of a claim, then rejection under 35 U.S.C. 102(b) is improper.⁷ Applicant is unable to locate in the Kaneko reference a first connector controller and a second connector controller that satisfy all of the requirements of Applicant's claims.

³ Office Action dated September 20, 2007, pg. 2, lines 18-21.

⁴ Kaneko, pg. 5, paragraph 54.

⁵ Office Action dated September 20, 2007, pg. 3, lines 6-8. ("... wherein the controller (29, 35) comprises a memory controller (30, 34) integrated with a first connector controller (not show) conforming to the first connector (25) standard and integrated with a second connector controller (not show) . . .") (emphasis added).

⁶ See *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 231 USPQ 81 (CAFC 1986) ("it is axiomatic that for prior art to anticipate under 102 it has to meet every element of the claimed invention").

⁷ *Id.* See also *Lewmar Marine, Inc. v. Barient, Inc.* 827 F.2d 744, 3 USPQ2d 1766 (CAFC 1987); *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (CAFC 1990); *C.R. Bard, Inc. v. MP Systems, Inc.*, 157 F.3d 1340, 48 USPQ2d 1225

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Moreover, because the Examiner also admitted that these elements are not shown and provides no citation to where they are allegedly taught in the specification, Applicant will assume that the Examiner has admitted that Kaneko fails to teach all of the elements of Applicant's claims. Thus, withdrawal of the rejection is respectfully requested, or at the very least, further clarification if the rejection is maintained in any subsequent Office Action.

Claim 23 includes similar limitations to those of independent claim 1. Thus, substantially the same arguments discussed above with respect to independent claim 1 are applicable to independent claim 23.

In light of the differences described with respect to the independent claims 1 and 23, Kaneko also fails to disclose or suggest the requirements of Applicant's dependent claims 7-9, 11-13, 23 and 25. Accordingly, claims 7-9, 11-13, 23 and 25 are allowable over Kaneko for at least the reasons described above with respect to claims 1 and 23.

Claims 15, 19, 20 and 27

Claim 15 is directed to a memory card comprising a memory, a first connector electrically coupled to the memory and conforming to a first connector standard, and a second connector electrically coupled to the memory and conforming to a second connector standard, wherein the first connector standard comprises a host computer connector (HCC) standard and the second connector standard comprises a device communication connector (DCC) standard. The memory card further comprises a first controller electrically coupled to the memory and the first connector, the first controller controlling the memory and output via the first connector, wherein the first controller comprises a memory controller integrated with a first connector controller conforming to the first connector standard. In addition, the memory card requires a second controller electrically coupled to the second connector and the first controller, the second controller controlling output via the second connector and conforming to the second connector standard, wherein the first connector is electrically coupled to the memory through the first controller, and the second connector is electrically coupled to the memory through the second controller and the first controller, wherein at least one of the first connector and the second

(CAFC 1998); *Oney v. Ratliff*, 182 F.3d 893, 51 USPQ2d 1697 (CAFC 1999); *Apple Computer, Inc. v. Articulate Systems, Inc.*, 234 F.3d 14, 57 USPQ2d 1057 (CAFC 2000).

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connector comprises a retractable connector that can be positioned in an extended position and a retracted position.

Applicant submits that Kaneko fails to disclose or suggest the invention defined in independent claim 15. As discussed above with respect to independent claim 1, Kaneko fails to disclose or *wherein at least one of the first connector and the second connector comprises a retractable connector that can be positioned in an extended position and a retracted position*, as is required by independent claim 15. As such, Applicant believes claim 15 to be allowable over Kaneko.

Moreover, Kaneko fails to disclose or suggest a memory card having a first connector conforming to a first connector standard, a second connector conforming to a second connector standard, wherein the first connector standard comprises a host computer connector (HCC) standard and the second connector standard comprises a device communication connector (DCC) standard and at least one of the connectors comprises a retractable connector as required by independent claim 15. As already discussed above with respect to independent claim 1, Kaneko fails to mention that connectors 25 and 27 may be used to connect the memory card to a host computer via a host computer connection (HCC) standard. Moreover, to the extent that Kaneko may disclose other connectors or I/O terminals that conform to two different standards, any such connectors or terminals are not retractable. Consequently, Kaneko fails to disclose or suggest all of the requirements of Applicant's claim 15.

In addition to the deficiencies already discussed above with respect to the rejection of claim 15, Applicant notes that "All words in a claim must be considered in judging the patentability of that claim against the prior art."⁸ Moreover, the totality of all the limitations of the claim and their interaction with each other must be considered to ascertain the inventor's contribution to the art.⁹

In the previous Office Action, the rejection of claim 15 fails to take into account the interrelatedness of the elements of the claim. In particular, claim 15 requires the first connector to be electrically coupled to the memory through the first controller, and the second connector to be electrically coupled to the same memory through the second controller and the first

⁸ In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970); MPEP § 2143.03.

⁹ MPEP § 2173.02.

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controller. If the rejection in the Office Action were proper, the Examiner would be able to point to a single memory in Kaneko that satisfied the Applicant's claim 15. However, the rejection identifies two different memories (28 and 32) on two different memory cards (21 and 22) as allegedly satisfying the requirements of Applicant's claim 15, which clearly recites a single memory.¹⁰ As such, Applicant respectfully requests withdrawal of this rejection or further clarification if the rejection is maintained.

Claim 27 includes similar limitations to those of independent claim 15. Thus, substantially the same arguments discussed above with respect to claim 15 are applicable to independent claim 27.

In light of the differences described with respect to the independent claim 15, Kaneko also fails to disclose or suggest the requirements of dependent claims 19 and 20. Accordingly, claims 19 and 20 are allowable over Kaneko for at least the reasons described above with respect to claim 15.

Claims 28-30

Claim 28 recites a memory card comprising a memory, a first connector electrically coupled to the memory and conforming to a first connector standard, and a second connector electrically coupled to the memory and conforming to a second connector standard, wherein the first connector standard comprises a host computer connector (HCC) standard and the second connector standard comprises a device communication connector (DCC) standard. The memory card further includes one or more controllers that control the memory and control output via the first connector and the second connector, wherein the first and second connectors are formed along a common side of the memory card and wherein electrical contacts of the second connector comprise a subset of electrical contacts of the first connector.

Applicant submits that Kaneko fails to disclose or suggest the invention defined in independent claim 28. In particular, Kaneko fails to disclose or *wherein the first and second connectors are formed along a common side of the memory card*, as is required by independent claim 28. Instead, Kaneko illustrates two sets of connector terminals (25 and 27) on two different memory cards (21 and 22). To the extent that memory cards (21 and 22) may be

¹⁰ Office Action dated September 20, 2007, pg. 6, lines 1-2.

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considered a single aggregate memory card (20), the connector terminals (25 and 27) are not formed along a common side of the aggregate memory card (20). Rather, the connector terminals are formed across the interior of the memory card (20). In support of the rejection, the Examiner stated "explained in claim 1".¹¹ Applicant, however, is entirely confused by this statement because the limitation of the first and second connectors being formed along a common side of the memory card is not included in claim 1 nor is the application of Kaneko with respect to this element explained in the rejection of claim 1. Accordingly, Applicant requests further explanation if this rejection is maintained in the next Office Action.

Moreover, Kaneko also fails to disclose or suggest *wherein electrical contacts of the second connector comprise a subset of electrical contacts of the first connector*. Instead, FIG. 3 illustrates connector terminals 25 and 27 as having separate and disjoint terminals. The Examiner provided no explanation for this rejection. Accordingly, Applicant requests further clarification if this rejection is maintained in any subsequent Office Action.

Applicant submits that Kaneko also fails to disclose or suggest each and every feature of Applicants dependent claims 29 and 30. As discussed above with respect to independent claim 1, Kaneko fails to disclose or suggest wherein at least one of the first connector and the second connector comprises a retractable connector that can be positioned in an extended position and a retracted position. Consequently, Kaneko also fails to disclose or suggest *wherein the second connector comprises a retractable connector that can be positioned in an extended position and a retracted position* as is required by claim 29.

Moreover, Kaneko fails to disclose or suggest the requirements of dependent claim 30. As already noted above, Kaneko makes no mention of a connector that can be positioned in an extended position and retracted position. Thus, Kaneko also fails to disclose or suggest wherein the electrical contacts of the second connector comprise movable contacts that form the second connector when the second connector is in the extended position, and wherein the electrical contacts of the second connector comprise a subset of the electrical contacts of the first connector when the second connector is in the retracted position as is required by dependent claim 30. Withdrawal of the rejection is requested.

¹¹ Office Action dated September 20, 2007, pg. 9, line 2.

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Kaneko fails to disclose each and every limitation set forth in claims 1, 7-9, 11-13, 15, 19, 20, 23, 25 and 27-30. For at least these reasons, the Examiner has failed to establish a prima facie case for anticipation of Applicant's claims 1, 7-9, 11-13, 15, 19, 20, 23, 25 and 27-30 under 35 U.S.C. 102(b). Withdrawal of this rejection is requested.

Applicant reserves further comments concerning the rejection of the dependent claims, but neither admits nor acquiesces in the propriety of the Examiner's interpretation of, or application of art to, such claims.

CONCLUSION

All claims in this application are in condition for allowance. Applicant respectfully requests reconsideration and prompt allowance of all pending claims. Please charge any additional fees or credit any overpayment to deposit account number 09-0069. The Examiner is invited to telephone the below-signed attorney to discuss this application.

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